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| EXAMINER | |
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3621 | |

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/819,174 | PAIZ, RICHARD S. | |
| | Examiner | Art Unit | MW |
| | Calvin L Hewitt II | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *27 March 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## *Status of Claims*

1. Claims 1-23 have been examined.

## *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The Applicant does not teach a method for bringing together a group of subscribers for a live performance. This is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Applicants method is directed to a specific user. However, in order for claim 18 to be realized, (see disc jockey analogy-Specification page 20, lines 13-23) the system would have to pool users requests and coordinate a specific viewing time when said song would be made available.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said system" in lines 15 and 16. There is insufficient antecedent basis for this limitation in the claim.

Claims 12-23 are also rejected as they depend from claim 11.

6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: pooling user requests and coordinating the broadcast such that it is available to a targeted group of users.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 6, 9, and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Payton, U.S. Patent No. 5,790,935.

As per claims 1-4, 6, 9, and 10 Payton teaches content distribution system comprising:

- a plurality of computers networked to one another, functioning as a single unit, said hierarchy including a first tier with at least one computer for subscriber billing tasks and managing tasks among said plurality of computers (figures 2, 4, 8 and 9), a second tier including a server for maximizing bandwidth and distributing content to users (abstract; figures 1-2 and 3c, 8 and 9), and a third tier including a plurality of computers containing individual subscriber id means and content accessing means (abstract; figures 2, 3c, 4, and 7a-9)
- work accessing means that comprises at least one of a live session, virtual reality representation of a site, wherein said site is a concert hall, and an interactive accessing session (e.g. virtual disk jockey) (column 6, lines 20-33)
- using encryption to prevent downloading of content and decrypting means for enabling downloading of content (figure 3b; column 7, lines 12-17)

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 11 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Berstis et al., U.S. Patent No. 6,282,653.

As per claim 11, Berstis et al. teach a method and system for providing access to content comprising: entering the world wide web via a system programming loaded onto a user computer (figure 7; column/line 4/55-5/16), requesting a content from a system (figures 1-3), making payment to the system for use of the content (figure 5; column 3, lines 8-24; column/line 5/32-6/20; column 9, lines 18-53) and directing payment for the use of the content to the copyright holder (column 5, lines 31-63; column 8, lines 8-35; column/line 9/64-10/11)

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton, U.S. Patent No. 5,790,935 in view of Eller et al., U.S. Patent No. 5,889,860.

As per claims 5, 7, and 8, Payton teaches a system for distributing content for a fee (abstract; figures 2 and 4). However, Payton does not specifically teach a specific payment method. Eller et al. teach a method and system for obtaining content using user login and credit card data for authentication and/or payment (figure 4; column 5, lines 45-56; column 6, lines 32-36). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Payton and Eller et al. in order to provide users with an efficient way to provide payment for accessing content.

13. Claims 12-17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al., U.S. Patent No. 6,282,653 in view of Goldhaber et al., U.S. Patent No. 5,794,210.

As per claim 12-17 and 21-23, Berstis et al. teach a method and system for providing access to content over the internet and compensating copyright holders for use of said content (figures 1-7). However, Berstis et al. do not specifically recite advertising. Goldhaber et al. teach a method and system for advertising goods and services over the internet (abstract; figures 1-4). Specifically, Goldhaber et al. teach maintaining an updateable user purchase profile (figure 11A; column 6, lines 32-62; column 12, lines 25-45) and providing credits to users for viewing user-specific advertisements with which said user can

use as payment for obtaining content (abstract; figures 3, 10, 11 and 13; column 6, lines 32-62; column/line 10/38-11/58; column/line 11/59-12/14; column 12, lines 45-60; column 15, lines 17-47). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Berstis et al. and Goldhaber et al. in order to allow advertisers to more accurately target consumers which in turn increases the revenues of content providers (e.g. copyright holders) ('210, column 12, lines 5-20).

14. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al., U.S. Patent No. 6,282,653.

As per claims 18 and 20, Berstis et al. teach a method and system for providing access to content over the internet (e.g. website) (figures 1-7). Upon receiving said content, it is rendered using display means such as a PC display and a browser (figure 7). The Berstis et al. system is dedicated to providing users with electronically distributed content (abstract). Therefore, as the image of a virtual DJ on a website is content, the Berstis et al. teaching reads on the limitations of claim 18.

Claims 18 and 20 attempt to distinguish themselves from the prior art by relying on "how" the content is being displayed on a website and by the actions of a "virtual DJ or maestro". However, it has been held that mere changes to aesthetic design (*In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA

1947)) and the automation of known processes are modifications to the content distribution method and system of Berstis et al. that would have been obvious to one of ordinary skill.

15. Claims 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al., U.S. Patent No. 6,282,653 in view of Payton, U.S. Patent No. 5,790,935.

As per claims 19, Berstis et al. teach a method and system for providing content over the internet (abstract; figures 1-7). However, Berstis et al. do not specifically recite presenting the content in particular sequence. Payton teaches a method and system for distributing content to users by collating specific user profiles and providing a user with a list of user selectable content in determined sequence based on said user profile (column 5, lines 5-54). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Berstis et al. and Payton in order to more efficiently provide content to users ('935, abstract).

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Kikuchi teaches a system for accessing performance sound and image data via a website
- De Rafael et al. teach a method and system for rewarding viewers of interactive ads
- Wolfe et al. teach music on-demand over the internet with targeted advertising

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

April 29, 2004